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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,072	11/21/2001	Asahiko Yamada	216413US2S	9750

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/989,072

Applicant(s)

YAMADA ET AL.

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 and 21-27 is/are rejected.  
7) ☐ Claim(s) 20 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/29/03  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-27 have been examined.

#### ***Priority***

2. The instant application claims priority to Japan Patent Application No. 2000-356239, filed 22 November 2000.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

4. The following Information Disclosure Statement in the instant application has been fully considered:  
  
IDS filed 29 May 2003.

#### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the

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description: items 12B, 13B, 14B, 15B, 16B, 21A, 22A, 23A, 24A. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: item 21 on page 35, line 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Each claim teaches solely to functional descriptive material that is not tangibly embodied.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-13 and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 22 recite the limitation "said setting" in page 48, line 26 and page 55, line 20, respectively. There is insufficient antecedent basis for this limitation in the

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claims. It is being presumed that the second program code confirms access privileges by performing a test that confirms other apparatuses by using data derived from the use of the first program code.

Specifically regarding claims 11 and 25, it is unclear to what the limitations using this particular term teach; therefore, they are not being considered.

Claims 10-13 depend from rejected claim 9, and include all the limitations of that claim, thereby rendering those dependent claims indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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9. Claims 9-11, 13-15, 18, 19, 22-24, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,510,513 to Danieli.

As per claim 9, the system disclosed by Danieli constitutes an originality-ensuring portal service (see abstract). The first entity and second entity acquire the first program code (see column 7, lines 28-35 and column 8, lines 39-42). The second program code, derived from the same code base, authenticates based upon the pre-registration of an entity; the trusted checks permission for the vendor and acts appropriately (see column 7, line 46 to column 8, line 3).

As per claim 10, the third party apparatus sends the vendor a certificate including a digital signature upon registering a file (see column 7, line 53 to column 8, line 19).

As per claim 11, the user acquires the certificate from the vendor and verifies it with the trusted third party (see column 8, lines 35-62). It is not clear to what the term "said setting" refers in this claim, and limitations involving that term are not being addressed, as noted above.

As per claim 13, signatures are checked to ensure authenticity (see column 8, lines 48-56).

As per claims 14, 15, 18, 22, 23, the certificates are maintained in a database, the security certificate registry, and are generally available. An example is given where a transmitting entity specifies multiple entities by certificate number; the certificates are based upon login information (see column 8, lines 5-6; column 9, lines 18-32; and column 24, line 38 to column 25, line 21).

Regarding claim 19, the login information is saved in the database.

As per claims 24, 25, the vendor receives an originality-ensuring digital signature from the trusted authority in response to the signature sent (see column 7, line 53 to column 8, line 27).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8, 12, 16, 17, 19, 21, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,510,513 to Danieli as applied to claims 9 and 22, above, and further in view of U.S. Patent No. 5,638,446 to Rubin further in view of U.S. Patent Application Publication No. 2001/0037313 to Lofgren et al.

Regarding claims 1-8, 12, 16, 17, 19, 26, and 27, Danieli discloses a system wherein a vendor (the first entity apparatus) sends a request (an issuance request) to a trusted arbiter (the third party apparatus) for a certificate for a file that includes a file digest, a timestamp (the first date information) and (the first digital signature) and a security certificate or a password for future authentication (the undeniable digital signature) (see column 7, lines 53-58; column 9, lines 10-13; column 13, lines 1-8; and figure 2C). These are all incorporated by the arbiter into a security certificate, which is



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both saved in a registry and sent to the vendor in a receipt (see column 13, lines 25-38). The security certificate is sent to a user (the second entity apparatus) acquiring the data and the user sends a notification message to the trusted authority (see column 9, lines 40-59).

Danieli disclose the passing of the serial number of the certificate, rather than the certificate itself.

Rubin discloses the sending by the trusted authority of the certificate, rather than just a reference to it (see column 5, line 57 to column 6, line 4). Rubin further notes that this allows the user to directly verify the authenticity of the certificate and the associated file (see column 6, lines 5-14).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Danieli by sending the actual certificate, rather than just a serial number, so that the user may directly verify the authenticity of the certificate and the associated file.

Danieli and Rubin do not disclose the sending of a second date information to the third party apparatus, or the issuing of a certificate with a third date information by the third party to the second entity.

Lofgren discloses the sending of a timestamp with a user request to the trusted authority (see paragraph 42) as well as the issuing of a new ticket (certificate) back to the second entity with using another timestamp (see paragraph 50) and further suggests that this prevents capture and playback by an unauthorized third party (see paragraph 48).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Danieli and Rubin by having the second entity send a second date to the third party and to have the third party issue a new ticket using another timestamp, as disclosed by Lofgren, in order to prevent capture and playback by an unauthorized third party.

Regarding claim 21, user information in the user registry is updated when a verification is found to be valid (see column 14, lines 42-46).

### ***Allowable Subject Matter***

11. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Danieli does not indicate the termination of a user session in the event of a valid verification, and no art could be found that would suggest a reason to do so.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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U.S. Patent No. 5,724,425 to Chang discloses the use of signatures in software distribution.

U.S. Patent No. 6,021,491 to Renaud discloses the use of signatures in file authentication.

U.S. Patent No. 6,363,365 to Kou discloses the use of a third-party authenticator in a bidding system.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.


Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



September 19, 2005



GREGORY MORSE  
SUPERVISORY PATENT  
TECHNOLOGY